



Serial No.: 09/293,835

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 067286/0204

In re patent application of

James C. KENNEDY *et al.*

Serial No.: 09/293,835

Group Art Unit: ~~1754~~

Filed: April 19, 1999

Examiner: ~~Hollinden~~

#14
#3098
12/20/01

For: PHOTOCHEMOTHERAPEUTIC METHOD USING 5-AMINOLEVULINIC ACID
AND OTHER PRECURSORS THEREOF

Reply Under 37 CFR § 1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This submission responds to the Office Action that issued September 13, 2001. A petition for a two-month extension of time is attached. If Applicants have not accounted for any fees required by this response, the Commissioner is authorized to charge the missing fees to Deposit Account No. 19-0741. In the absence of an explicit request from Applicants, the PTO also is requested to grant any needed extension of time under 37 CFR 1.136, and to charge the corresponding fee to the aforementioned account. Prior to reconsideration on the merits, please amend the captioned application as set out below.

Remarks

The examiner has required election of four species for examination purposes. Applicants elect the following species: (1) fungus (agent of exogenous origin); (2) skin (tissue); (3) onchomycosis (disorder); (4) 5-aminolevulinic acid (precursor of protoporphyrin IX). Applicants note that onchomycosis is known in the art as a cutaneous fungal infection, one that infects the nails. See Example 9. Therefore, for purposes of examination of this application nails are considered within the elected tissue skin.

Applicants traverse the restriction requirement on the grounds that the Examiner has failed to establish that a search of the complete application would be an undue burden as required by MPEP 803. The Examiner concludes that the search and examination of both inventions would not be completely coextensive in scope. However, MPEP 803 states: "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." It is Applicants' position that the Examiner has failed to establish that a search of the entire application constitutes an undue burden. Therefore, it is requested that the entire application be searched and examined.

Applicants request that the Examiner follow the procedure for election of species according to MPEP § 803.02 which sets forth manner for handling "Markush" type claims.

Should the Examiner have any questions regarding the present application or believe that further discussion will advance prosecution, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

December 13, 2001
Date

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